

**REMARKS**

Claims 2-7, 9-35 and 37 are pending. Claims 2-7, 22-35 and 37 stand rejected and claims 9-21 are withdrawn from consideration.

No new matter has been added by way of the present amendments. For example, each of claims 22, 26 and 37 were amended to reflect that the powder coatings form a single layered coating film having a homogeneous hue. This subject matter is supported by the present specification at page 8, lines 2-13, and the present Examples. Accordingly, no new matter has been added.

A marked up version showing changes made is attached hereto for the Examiner's consideration.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 USC § 103(a)

Claims 2-7, 22-35 and 37 stand rejected as being obvious over Millar et al., USP 3,860,557 (hereinafter referred to as Millar '557). Applicants respectfully traverse this rejection.

The Present Invention and its Advantages

The present invention relates to a combination of two or more powder coatings usable in a powder coating method for forming a coating film having a visually homogeneous hue. The coating film

resulting from applying the combination of the powder coatings of the present invention results in a single layer having a homogeneous hue. The single layer having a homogeneous hue is achieved by the present invention by controlling the difference in the triboelectric charge of each powder within a given range. In particular, the difference in triboelectric charge of said two or more powder coatings is  $5.0 \mu\text{C/g}$  or less.

Other parameters, such as the difference in average particle size, true specific gravity, apparent density, softening point, dielectric constant, and electric resistance of each of said two or more powder coatings are kept within specific ranges. Due to the nature of the powder coatings of the present invention, a single layered film can be achieved having a homogeneous hue.

#### Distinctions Between the Present Invention and Millar '557

Millar '557 relates to an electrostatic method of applying a multi-layered coating and products produced thereby. The multi-layered coating of Millar '557 is formed by applying to a substrate a composition containing two or more powders, provided that the powders of non-conductive materials have dielectric constants that differ from each other by a factor of at least 0.1. After the composition of Millar '557 is applied to the substrate, stratified layers of different powders form due to the different dielectric constants (Millar '557 at column 3, lines 1-11 and 42-45). Accordingly, the entire aim of Millar '557 is to form a

multi-layered coating. Millar '557 is completely silent as to the formation of a single layered coating. Applicants submit that it is not surprising that Millar '557 is silent in this regard since, as noted above, Millar '557 is interested in obtaining stratified layers containing different powders.

In contrast, the present invention is directed to a single layered coating having a homogeneous hue. The single layered coating of the present invention is made up of two or more powder coatings. Accordingly, Millar '557 fails to suggest or disclose an element of the presently claimed invention. Thus, the Examiner has failed to establish a valid *prima facie* case of obviousness.

During prosecution, the interpretation of column 4, lines 8-15 has been disputed. The relevant portion of Millar '557 at column 4, lines 8-15 reads as follows:

Normally, the coating compositions of the present invention will utilize 2 or 3 different components, to produce a resulting 2 or 3 layer coating on the substrate. It will, of course, be realized that one component or one final layer in the coating may be itself a mixture of two or more specific materials - e.g., two or more thermoplastic polymers having quite similar dielectric constants and quite similar specific gravities. When 3, 4, 5 or even more distinct coating components are utilized to produce 3, 4, 5 or even more layers in the final coating, each of the components should differ from the other components by the differentials set forth above as to dielectric constant, or chargeability, and specific gravity.

The Examiner asserts that this citation teaches a powder coating composition containing at least two different powders having quite similar dielectric constants and quite similar

specific gravities. However, Applicants submit that the Examiner has read this citation out of context. Specifically, throughout the entire reference, Millar '557 refers to separate powders as "components." For example, in the above citation, Millar '557 refers to "distinct coating components" when referring to powders in separate layers. Thus, Millar '557 is utilizing the word "component" interchangeably with "powder." However, in the phrase that the Examiner asserts that Millar '557 is referring to different powders, Millar '557 uses the words "materials" (e.g., two or more thermoplastic polymers) and not "components." This is the first evidence that the Examiner has incorrectly interpreted the citation of Millar '557.

Applicants submit that had Millar '557 wished to teach a single layer containing different powders, Millar '557 would have disclosed that the single layer was a mixture of at least two different components. However, this was not the case. In fact, the proper interpretation of the above passage is that Millar '557 is teaching that a single powder (or "component") can itself be composed of two or more materials. For example, a single powder would consist of two or more thermoplastic polymers having similar dielectric constants and specific gravity.

Applicants interpretation is completely consistent with the entire disclosure of Millar '557, not just an isolated sentence taken out of context. A review of Millar '557 reveals that Millar '557 fails to provide even a single Example, wherein a single

layer contains two or more powders, much less an Example containing two or more powders in a single layer, wherein the color of each powder is different. In fact, with the exception of the above disputed passage, Millar '557 always discloses multi-layered structures containing a single powder in each individual layer. Accordingly, the Examiner has selected specific elements from Millar '557, read those elements out of context, and ignored other elements. Applicants submit that this is an improper manner to construct a rejection under 35 USC § 103(a).

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 147 U.S.P.Q. 391 (CCPA 1965). As discussed above, Applicants submit that the Examiner has done exactly this, pick and choose elements from Millar '557 while ignoring others, in formulating the rejection under 35 USC § 103(a). Thus, the present rejection is improper and should be withdrawn.

If the Examiner has any questions concerning this application, he is requested to contact the Craig A. McRobbie (#42,874) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional

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fees required under 37 C.F.R. § 1.16 or under § 1.17;  
particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims were amended as follows:

22. (Amended) A combination of two or more powder coatings [for forming a coating film having a visually homogeneous hue], comprising two or more color powder coatings wherein the color of each powder coating is different, wherein a difference in triboelectric charge of said two or more powder coatings is 5.0  $\mu\text{C/g}$  or less; [and] wherein particles of each powder coating are not agglomerated; and wherein said two or more powder coatings form a single layered coating film having a homogeneous hue.

26. (Amended) A powder coating composition [capable of forming a coating film having a visually homogenous hue] which comprises two or more color powder coatings wherein the color of each powder coating is different, a difference in triboelectric charge of said two or more powder coatings is 5.0  $\mu\text{C/g}$  or less; [and] wherein particles of each powder coating [is] are not agglomerated, and wherein said two or more powder coatings form a single layered coating film having a homogeneous hue.

37. (Amended) A powder coating composition, comprising two or more color powder coatings, each of said two or more powder coatings comprising:

a resin; and

at least one colorant, wherein

(1) each of said two or more color powder coatings has a different color,

(2) a difference in triboelectric charge of said two or more color powder coatings is 5.0  $\mu\text{C/g}$  or less,

(3) the particles of each color powder coating are not agglomerated, and

(4) said powder coating composition forms a single layered coating film having a visually homogeneous hue.